

REMARKS

Claims 1-12 are pending in this application. Claims 8-12 are withdrawn from consideration as being directed to a non-elected invention. In light of the amendments and remarks set forth below, Applicants respectfully requests a notice of allowance for pending claims 1-7.

Applicants include herewith a certified copy of P2001-032795 as required by 35 U.S.C. § 119(b). Applicants respectfully request acknowledgement of the filing of the certified priority document.

In the Final Office Action issued July 1, 2003, claim 1 was rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 5,405,136 (“Hardman”). Applicant respectfully traverses this rejection.

To anticipate a claim under 35 U.S.C. § 102, the cited reference must disclose every element of the claim, as arranged in the claim, and in sufficient detail to enable one skilled in the art to make and use the anticipated subject matter. See, PPG Industries, Inc. v. Guardian Industries Corp., 75 F.3d 1558, 1566 (Fed. Cir. 1996); C.R. Bard, Inc. v. M3 Sys., Inc., 157 F.3d 1340, 1349 (Fed. Cir. 1998). A reference that does not expressly disclose all of the elements of a claimed invention cannot anticipate unless all of the undisclosed elements are inherently present in the reference. See, Continental Can Co. USA v. Monsanto Co., 942 F.2d 1264, 1268 (Fed. Cir. 1991).

According to the present invention, the metal golf club head has a ball hitting face which is made of metal. The central portion of the ball hitting face has a

first hardness and the peripheral portion of the hitting face has a second hardness. The hardness of the peripheral portion of the ball hitting face is lower than the hardness of the metal at the central portion. It should be noted that the hardness of the metal material varies from the center to the peripheral portions of the face.

In the Hardman reference, the hardness between the center and peripheral portion of the face is changed by changing face inserts. Hardman discloses a wooden golf club head with a plastic, resin, epoxy composite, etc. insert material for the face of the club. All of these are organic materials and not metal as explicitly recited in Applicants' claim. Thus claim 1 is allowable over Hardman.

Claims 2-7 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Hardman in view of U.S. Patent No. 5,346,216 ("Aizawa"). Applicants respectfully traverse this rejection.

To establish a *prima facie* case of obviousness, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify a reference or combine references to arrive at the claimed subject matter. The prior art references must also teach or suggest all the limitations of the claim in question. See, M.P.E.P. § 706.02(j). A reference can only be used for what it clearly discloses or suggests. See In re Hummer, 113 U.S.P.Q. 66 (C.C.P.A. 1957); In re Stencel, 4 U.S.P.Q.2d 1071, 1073 (Fed. Cir. 1987). Here, the references, whether taken individually or in combination, do not disclose or suggest the invention claimed by the Applicants.

Claim 2 recites a metal golf club head wherein “the hardness of the metal at said peripheral portion is smaller than the hardness of the metal at said central portion.” As discussed above, Hardman fails to disclose a metal golf club head where the hardness of the face varies within in the material itself. The Office Action includes Aizawa not to cure this deficiency but to show a face insert that varies in thickness to improve energy transfer. However, this is unlike Applicants’ explicitly recited invention and wherein the hardness of the material itself changes without varying the thickness of the face. Any change in hardness in the cited references between the center and the periphery portion of the face is accomplished by changing a thickness of the material itself. Neither of the references teach or suggest to change the hardness of the metal material itself at the center and periphery of the portion of the face. As such, claim 2 is allowable over the cited references.

Claims 3, 5, and 7 depend from, and contain all the limitations of claim 1. These dependent claims also recite additional limitations which, in combination with the limitations of claim 1, are neither disclosed nor suggested by Hardman and are also believed to be directed towards the patentable subject matter. Thus, claims 3, 5, and 7 should also be allowed.

Claims 4 and 6 depend from, and contain all the limitations of claim 2. These dependent claims also recite additional limitations which, in combination with the limitations of claim 2, are neither disclosed nor suggested by Hardman and are also believed to be directed towards the patentable subject matter. Thus, claims 4 and 6 should also be allowed.

Applicant has responded to all of the rejections and objections recited in

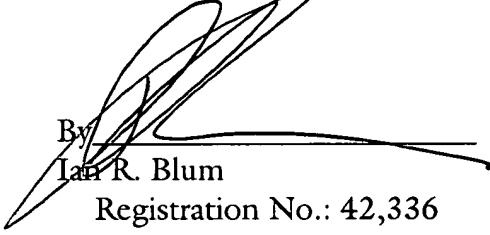
the Office Action. Reconsideration and a Notice of Allowance for all of the pending claims are therefore respectfully requested.

In view of the above, each of the presently pending claims in this application is believed to be in immediate condition for allowance. Accordingly, the Examiner is respectfully requested to withdraw the outstanding rejection of the claims and to pass this application to issue.

If the Examiner believes an interview would be of assistance, the Examiner is welcome to contact the undersigned at the number listed below.

Dated: October 1, 2003

Respectfully submitted,



By
Ian R. Blum

Registration No.: 42,336
DICKSTEIN SHAPIRO MORIN &
OSHINSKY LLP
1177 Avenue of the Americas - 41st Floor
New York, New York 10036-2714
(212) 835-1400
Attorney for Applicant

IRB/mgs